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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/005,727 01/19/93 LEVINE

26M2/1221

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M LVN-023	
EXAMINER	
FLYNN, N	
ART UNIT	PAPER NUMBER

2602

DATE MAILED: 12/21/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 11-27-93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-692. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTQ-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15 _____ are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1-10 _____ are allowed.
4. ☒ Claims 11-13 _____ are rejected.
5. ☒ Claims 14 and 15 _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 11-13 are still rejected under 35 U.S.C. § 103 as being unpatentable over Rumbolt et al.

Regarding amended claim 11, Rumbolt et al. disclose all of the steps claimed:

A. "transmitting test control codes to the associated unit" is disclosed in the abstract and shown in the flow chart in fig. 5;

B. "electronically analyzing the resulting operation of the associated unit in order to determine its control codes" is disclosed in the abstract and performed by the operator visually monitoring the device under test, deciding when the correct

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response occurs and breaking an opening a switch in an electronic circuit by releasing the "learn button";

C. "storing the control codes in a memory" is disclosed in the abstract and performed by microprocessor 10.

In reference to claims 12 and 13, Rumbolt et al. further disclose the claimed subject matter.

The inclusion of structural limitations in the preamble of a method claim is of no patentable moment unless it affects the process in a manipulative sense. Ex parte Kangas, 125 USPQ 419 (PTO Bd. App. 1960). The structure in the preamble of method claims 11-12 does not effect the process in a manipulative sense and is just the mere claiming of a use of a particular structure.

The applicant has stated in the amendment the claimed invention (claim 11-13) is patentable over the teaching of Rumbolt et al. because the claimed step of "electronic analysis" is not disclosed by Rumbolt et al. The examiner has pointed out in the rejection of amended claim 11 that step of analysis taught by Rumbolt et al. at least in part is performed electronically by the releasing of the "learn button". Therefore, under the broadest reasonable interpretation of the claims, the rejection is deemed proper. (1) Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE**

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FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan J. Flynn whose telephone number is (703) 308-6601

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Nathan J. Flynn
December 15, 1993

VICTOR R. KOSTAK
PRIMARY EXAMINER
ART UNIT 262

WLB